

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKE A. MARGUCCI

Appeal No. 1999-0660
Application No. 08/312,406

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, COHEN and MCQUADE,
Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL
AND
ORDER UNDER 37 CFR § 1.196(d)

This is a decision on an appeal from the examiner's final rejection of claims 1 through 10.¹ No other claims are pending in the application. An Order under 37 CFR § 1.196(d) is presented at the end of this decision following our new ground of rejection under 37 CFR § 1.196(b).

¹ Claim 1 was amended subsequent the final rejection (Paper No. 7 mailed July 9, 1996) to overcome a rejection under the first paragraph of 35 U.S.C. § 112.

The claimed invention relates to a “formable plastic product” (claim 1, line 1)² having an outer tubular plastic sheath (12) and a bendable or deformable forming member (15) received in the internal passageway defined by the sheath. As disclosed, the forming member is made from a material such as hanger wire (see page 10 of appellant’s specification) to retain its bent or deformed shape. The sheath is flexible to conform to the bent or deformed shape of the forming member.

A copy of the appealed claims is appended to appellant’s brief.

The following references are relied upon by the examiner as evidence of anticipation and obviousness in support of his rejections under 35 U.S.C. § 102(e) and § 103(a):

| | | |
|------------------------|-----------|---------------|
| Killop et al. (Killop) | 4,453,353 | Jun. 12, 1984 |
| Quigley | 5,437,899 | Aug. 01, 1995 |

The grounds of rejection are as follows:³

1. Claims 1 through 3 and 5 through 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Quigley.

2. Claims 1, 4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Quigley.

3. Claims 1 through 9 additionally stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Killop.⁴

Reference is made to the examiner’s answer for details of these rejections.

² It is misdescriptive to recite that the claimed product is a “plastic product” because all of the parts of the product are not made from plastic.

³ With regard to the 35 U.S.C. § 112 rejections made in the final office action (Paper No. 7), the rejection of the appealed claims under the first paragraph of § 112 has been withdrawn (see the advisory office action mailed August 28, 1996) and the rejection of the appealed claims under the second paragraph of § 112 has also been withdrawn (see the answer mailed April 1, 1997).

⁴ This is a new ground of rejection introduced in the examiner’s answer of April 1, 1997.

Discussion Regarding The Standing Rejections

With regard to the rejections based on Quigley, appellant argues inter alia that Quigley's central forming member 10 is not in opposed facing relationship with the outer sheath 13 because of the presence of the intermediate annular member 12 in the patentee's embodiment of Figure 1. We agree with the examiner, however, that the appealed claims are not drafted in such a way to exclude Quigley's intermediate member 13. The "facing" relationship recited in claim 1, to the extent that the claim language is understandable,⁵ does not require an annular void space to be present between the forming member and the sheath as appellant seems to argue.

Notwithstanding our agreement with the examiner on the foregoing matter, we cannot sustain any of the rejections of the appealed claims without resorting to speculation about certain indefinite language in claim 1, which is the only independent claim on appeal. In light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse the examiner's decision to reject claims 1-3 and 5-9 under § 102(e) as anticipated by Quigley, the examiner's decision to reject claims 1, 4 and 10 under § 103(a) as unpatentable over Quigley and the examiner's decision to reject claims 1-9 under § 103(a) as unpatentable over Killop. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the standing rejections.

⁵ See our new ground of rejection under 35 U.S.C. § 112, second paragraph.

New Ground of Rejection

Under the provisions of 37 CFR § 1.196(b), the following new ground of rejection is entered against claims 1 through 10:

Claims 1 through 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention. Our difficulty with the claim language centers on the following recitation in claim 1:

said forming member including an outer surface portion which is unbonded to said sheath and unsupported thereby and spaced from intimate contact therewith with the internal passageway of said sheath and said outer surface portion of said forming member being in opposed facing and spaced relationship with said outer tubular sheath . . .

The foregoing claim limitation is rendered incomprehensible by the phrase “with the internal passageway of said sheath.” Perhaps this phrase should have been deleted when claim 1 was amended in the amendatory paper filed April 8, 1996, but it would be speculation on our part to conclude that appellant intended to omit this phrase. In the final analysis, appellant must recite what he regards as his invention. See 35 U.S.C. § 112, second paragraph.

In summary, the examiner’s decision rejecting the appealed claims is reversed, and a new ground of rejection has been entered against the appealed claims pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner
- (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Order Under 37 CFR § 1.196(d)

Appellant is required to respond to this Order by supplying the information requested infra in the event that appellant chooses either of the foregoing options under 37 CFR § 1.196(b).

This Order is concerned with the relationship between the forming member (15) and sheath (12). In this regard, the forming member is shown in Figures 1 and 2 of the drawings to be suspended in the sheath in spaced relation to the sheath, with no apparent means for supporting the forming member in the sheath. It thus is unclear how the forming member is supported if, as recited in claim 1, it does not contact the sheath. Alternatively, it is unclear how the sheath is supported if there is no contact between the

sheath and the forming member. It also is unclear how the sheath may be made to conform to the selected shape of the forming member (e.g., the shape of Figure 3 or the shape of Figure 4) if the forming member does not contact the sheath as recited in claim 1.

Thus, in the event that appellant chooses either of the foregoing options under 37 CFR § 1.196(b), appellant is ORDERED under 37 CFR § 1.196(d) to:

1. Explain how the forming member (15) shown in Figures 1 and 2 and recited in claim 1 is supported if, as stated in claim 1, it is not supported by the sheath (12) and is spaced from intimate contact with the sheath.

2. Point out by page number and line number where the specification discloses the support described in Item 1 supra.

3. Explain how the sheath (12) is supported if, as set forth in claim 1, there is no contact between the forming member (15) and the sheath (12).

4. Point out by page number and line number where the specification discloses the support described in Item 3 supra.

5. Explain how the sheath (12) may be made to conform to the selected shape of the forming member (15) (e.g., the shape of Figure 3 or the shape of Figure 4) if, as set forth in claim 1, there is no contact between the forming member and the sheath.

The period for responding to the foregoing Order under 37 CFR § 1.196(d) is set to expire TWO months from the mailing date of this decision.

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No time period for taking any subsequent action in connection with this appeal or the accompanying Order may be extended under 37 CFR § 1.136(a).

REVERSED/ 37 CFR § 1.196(b)/37 CFR § 1.196(d)

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| HARRISON E. MCCANDLISH |) | |
| Senior Administrative Patent Judge |) | |
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| |) | |
| |) | BOARD OF PATENT |
| IRWIN CHARLES COHEN |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| JOHN P. MCQUADE |) | |
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